

REMARKS

In the present Action, claims 1-7, 9-22 and 24-53 are pending. In addition, the Examiner withdrew claims 9-18 and 30-45 from further consideration. Applicants have amended claim 22 to overcome a restriction requirement under 35 U.S.C. §121. Support for this amendment is found at page 32, line 14 – page 34, line 21 and page 48, lines 1-15. Upon entry of this amendment, claims 1-7, 19-22, 24-29, 46-53 will be pending for examination on the merits.

In addition, Applicants have also amended claims 4 and 6 by inserting the term “essentially” between “consisting” and “of.” Applicants inadvertently deleted this term in the Supplementary Preliminary Amendment filed June 25, 2002. Support for this amendment is found in pages 85 (claim 5) and 86 (claim 6).

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented with an appropriate defined status identifier. The amendment does not go beyond the original disclosure of the application.

In the present Office Action, the Examiner further restricts the subject matter of elected claims 1-7, 19-22, 24-29 and 46-53 to Groups 1-XLII (see sections 6-8 of the Office Action mailed June 5, 2003). Under this restriction, the Examiner requires that the Applicants “elect a single invention by specifically identifying *a single pair of primers to which the claims are to be drawn*” (emphasis added). Applicants respectfully traverse the restriction requirement.

Applicants appreciate the courtesy extended by Examiner Rawlings during a telephone interview with Applicants’ representative, Cecilia A. Lopez-Chua, on June 26, 2003. During the interview, the Examiner recommended revising claim 22 in the manner set out above. With this amendment, therefore, the restriction requirement has been obviated.

Election of Species Requirement

In addition, the Examiner stated that claims 1-7, 20-22, 24-29, and 46-53 are “generic to a plurality of disclosed patentably distinct species comprising the inventions of claims 1, 20, 24 and 25, wherein said transcription associated biomolecule is selected from [a prescribed] group...”

In response, Applicants elect species (d), namely, "a nuclear hormone receptor or the DNA-binding domain thereof." The Examiner is reminded that a species election is solely for search purposes. Pursuant to M.P.E.P. §803.02, a finding of patentability as to the elected species will oblige the Examiner to extend his search to the species within the recited genus.

In accordance with the foregoing, examination on the merits is requested. Should there be any questions or should the Examiner wish to discuss any proposal to expedite prosecution, the Examiner is invited to contact the undersigned representative at the telephone number shown below.

If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date

22 July 2003

By

S. A. Bent

FOLEY & LARDNER
Customer Number: 22428



22428

PATENT TRADEMARK OFFICE

Telephone: (202) 672-5404

Facsimile: (202) 672-5399

Stephen A. Bent
Attorney for Applicant
Registration No. 29,768